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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,338	12/05/2001	Michael Wengrovitz	47339/JEC/X2/134066	6485

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EXAMINER

NGUYEN, TRONG NHAN P

ART UNIT PAPER NUMBER

2152

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,338

Applicant(s)

WENGROVITZ, MICHAEL

Examiner

Jack P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 and 37-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/29/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-39 are being examined.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Group 1: Claims 1-17 are drawn to a method for establishing a computer-to-computer SIP session in 709, subclass 227.
- II. Group 2: Claims 18-36 are drawn to a system for interfacing between a computer with a server computer to perform data processing in class 709, subclass 206.
- III. Group 3: Claims 37-39 are drawn to a system for establishing a negotiation with another computer in order to transfer data between the computers in class 709, subclass 202.

Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. Invention I has a separate utility such as in a method for establishing a SIP session between remote devices. Invention II has a separate utility such as in a system for receiving and distributing a request to another server for load balancing between servers. Invention III has a separate utility such as in a system for tracking website usage. See MPEP § 806.05(d).

These inventions are distinct for the reasons given above, and the search required for each Group is different and not co-extensive for examination purpose. For example, the searches for the two inventions would not be co-extensive because these

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groups would require different searches on PTO's classification class and subclass as following:

(a) Group I search (claims 1-17) would require use of search **Class 709, subclass 227.**

(b) Group II search (claims 18-36) would require use of search **Class 709, subclass 206.**

(c) Group III search (claims 37-39) would require use of search **Class 709, subclass 202.**

A telephone call was conducted with Mr. Craig Hoersten, the applicant's representative, on February 10, 2005 to address the possibility of a restriction election.

The applicant selected group II without traverse.

Claims 1-17 and 37-39 are withdrawn from consideration.

Claims 18-36 are now presented for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 18-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 11-15 of copending Application No. 10/020783. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the copending application have all the limitations in the claims of the present application. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Lines 23-24 recite, "...the first server coupled to a second server..." Lines 26-27 recite, "...the server further determining..." This limitation is indefinite because it is not clear which server is performing this determination function. For the purpose of examination, Examiner interprets the second server is performing this function.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 18-20 and 26-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Sidhu et al, 6,744,759 (Sidhu hereafter).

As per claim 18, Sidhu teaches a communication system adhering to a session initiation protocol (SIP), the system comprising (col. 8, line 4): a first device (208a, fig. 2a); a second device (218b, fig. 2a, col. 8, lines 33-35; first and second devices are Internet phones); and a server (150a, fig. 2; now refers to as telephony connection server 'TCS' or internet service provider 'ISP') operative between the first device and the second device (see fig. 1), characterized in that the first device transmits to the server a call establishment message for establishing a SIP session, the server receiving the call establishment message and in response, causing retrieval of information stored in the first device (col. 7, lines 43-46; col. 10, lines 57-62; col. 10, lines 64 – col. 11, line 1; col. 11, lines 10-15; col. 12, lines 49-50; col. 13, lines 1-3; client A (208a, fig. 2a) sends a registration request to its local TCS (150a, fig. 2a) or ISP (120, fig. 2a) server to establish a SIP session; the server acknowledges the request and sends a response requesting the client device to indicate the services the client device is requesting; the client then sends the address of the second device to the server requesting a connection session with the recipient device), the server further determining an address of the second device based on the retrieved information and using the address for routing the SIP session to the second device (col. 14, lines 13-16; after the client (208a, fig. 2a) has established communications with the connection host server (150a, fig. 2a),

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the client sends a telephony request to the server wishing to establish connection with the recipient client (218a, fig. 2a); the request, based on subscribed features or services, includes the address of the recipient client; the server uses this address to establish communications between the two devices).

As per claims 19-20, Sidhu teaches the information includes information gathered about a user of the first device and interactions of the user with a particular web site (col. 14, lines 13-16 & lines 48-49; user profile information includes user name, address, etc.; and URLs represents Internet web site addresses).

As per claims 26, Sidhu teaches the server transmits new information to be written in the first device for use in routing future SIP sessions initiated by the first device (col. 14, lines 25-34; col. 18, lines 15-18; connection server transmits updated subscription data to client device for future use).

As per claim 27, Sidhu teaches server transmit the retrieved information to the second device (col. 14, lines 13-16; the server receives the address of the recipient device from the sending device in order to set up a SIP session between the two devices).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25 and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sidhu, 6,744,759 (Sidhu hereafter) in view of Law et al, 6,330,602 (Law hereafter).

Claim 28 recites similar limitations as claim 18; therefore, it is rejected based on similar reasons as claim 18 addressed above. Sidhu further teaches the first server (150a, fig. 2a) coupled to a second server (160, fig. 2a; local connection server may be connected to another host server). Sidhu does not explicitly disclose transmitting an address of the second server to the first device for causing retrieval of information stored in the first device. However, it is well known in the art to use a helper server to offset the load on the first server; the redirecting server (14, fig. 1) sends the IP address of the desired server (18, fig. 1) to the client so the client can conduct transactions with the desired server (see Law – col. 2, lines 14-18). Therefore, it would have been obvious to one of ordinary skill in the art to use an external server to help process transactions to reduce the load on the first server as disclosed by Law in col. 2, lines 35-36.

Claims 21-25 are rejected for similar rationale as claim 28 addressed above. Sidhu further teaches the address is associated with a hypertext markup language link and address is transmitted in a response SIP message to the first device (col. 14, lines 13-16; col. 15, lines 59-62; SIP URLs are addresses that are associated with HTML hot links; connection servers are also web servers capable of processing URLs and hosting HTML pages as shown in element 451, fig. 4a).

Claims 29-30 are rejected using similar rationale as claims 19-20 above.

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Claims 31-34 are rejected using similar rationale as claims 21-25 above.

Claims 35-36 are rejected using similar rationale as claims 26-27 above.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Schuster et al, 6,446,127; Schuster et al, 6,681,252 ; Bennett III et al, 6,154,528 ; Donovan, 6,434,143 ; Mattaway et al, 6,226,678 ; Krishnaswamy et al, 5,867,494 ; Gallant et al, 6,636,596 ; Glitho et al, 6,625,141

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack P Nguyen whose telephone number is (571) 272-3945. The examiner can normally be reached on M-F 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jpn



Dung C. Dinh
Primary Examiner